

### REMARKS

Claims 1-24 and 44-45 are pending; claims 25-43 stand withdrawn.

#### **Rejections under 35 U.S.C. § 112, second paragraph**

Claims 1-24, 44 and 45 have been rejected for indefiniteness under 35 U.S.C. § 112, second paragraph. In particular, the Examiner argues that the terms "fixable" in claims 1 and 44 and "may be" in claims 8, 10 and 16 render the claims indefinite. See the Office Action at 2-3.

The standard for determining definiteness focuses on "whether the claim apprises one of ordinary skill in the art of its scope." MPEP 2173.02. Definiteness is analyzed in light of "(A) The content of the particular application disclosure; (B) The teachings of the prior art; and (C) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made." *Id.*

The Examiner contends that "'fixable' is not clearly defined in the claims or specification" and that because "[t]he term has multiple meanings . . . it is not clear to the examiner which definition the application intended to apply to the term." Applicants respectfully disagree.

When the term "fixable" is considered in light of the specification (e.g., at pages 15, 18, and 21, and in the Figures, especially Figures 1 and 2) and the word's own plain meaning, the claim is clear to a person of ordinary skill in the art.

Claims 8, 10 and 16 have been amended so as to avoid the term "may be." Applicants believe claims 8, 10 and 16 fully comply with the requirements of § 112, second paragraph.

#### **Rejections under 35 U.S.C. § 102**

##### Dolan

Claims 1 and 7 have been rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,136,182 to Dolan et al. ("Dolan"). See the Office Action at 4-6. In making the rejection, the Examiner contends that Dolan discloses "a lid element having a detection surface with a substance library on its underneath side . . . (e.g. see figure 1, element 14; see also column 12, lines 28-45)." *Id.* at 4-5. Applicants respectfully disagree.

Claim 1 relates to a device for holding a substance library carrier. The device includes two holding elements that are fixable with each other, and that form a layer composite that includes: (i) a lid element having a detection surface with a substance library on its underneath side and being optically translucent at least in an area of the detection surface, (ii) a sealing intermediate element having an enclosed recess; and (iii) a base element being optically translucent at least in an area of the detection surface of the lid element. The lid element, the intermediate element and the base element together form an optically translucent chamber having a chamber space. See claim 1.

Dolan does not describe a lid element having a detection surface with **a substance library** on its underneath side. The structure the Examiner mentions (element 14 in Dolan Fig. 1) is described as a "top wall member" (column 12, line 37) formed of "a non-magnetic transparent material" (column 12, lines 43-44) and optionally having "[f]iducial reference marks" (column 12, line 53) (the descriptions in column 12 refer to Figs 5A and 5B). Rather than describing that top wall member 14 has a substance library on its underneath side, Dolan explains that a "ferromagnetic collection structure" can be formed upon its interior surface (column 12, lines 57-59). Nowhere does Dolan teach or describe a substance library of any kind. Thus Dolan fails to teach or describe a lid element having a detection surface with **a substance library** on its underneath side. Because Dolan does not teach all the limitations of independent claim 1 or the claims that depend from it, the claims are patentable over Dolan. Applicants respectfully ask that the Examiner reconsider and withdraw this rejection.

#### Ehricht

Claims 1-4, 7-8, 10, 12, and 18-24 have been rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No. 2002/0150933 by Ehricht et al. ("Ehricht"). Claim 1 is independent. The Examiner argues that Ehricht "discloses two holding elements that are fixable with each other (for example, see figure 1 [sic, figure 2] wherein the 'two sides' of element 42 represent 'holding elements' and they are 'fixed' at a distance equal to the length of element 2.)" See the Office Action at page 6. Applicants respectfully disagree.

The Examiner misinterprets figures 1-2 of Ehricht. Ehricht does not disclose "two holding elements that are fixable with each other" as the Examiner asserts, but instead a **single** chamber body (element 1). See, e.g., paragraph 0055: "Device 20 . . . consists of a chamber body 1 . . . ." Figures 1 and 2 of Ehricht are reproduced below for reference.

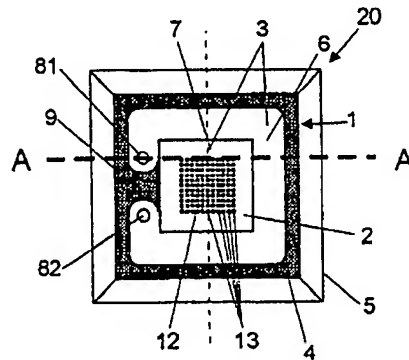


Fig. 1

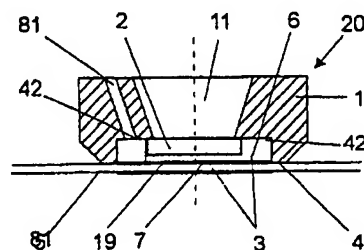


Fig. 2

Thus, Ehricht does not disclose **two** holding elements that are fixable with each other, and therefore does not anticipate claim 1 or the claims that depend from it. Applicants respectfully ask that the rejection be reconsidered and withdrawn.

### Blackburn

Claims 44 and 45 have been rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No. 2006/0160205 to Blackburn et al. ("Blackburn"). See the Office Action at page 10. Blackburn relates generally to biochip multiplexing (abstract). Independent claim 44 relates to a first device for filling a second device for holding a substance library carrier. The second device includes two holding elements that are fixable with each other, and that form a layer composite. The layer composite includes (i) a lid element having a detection surface with a substance library on its underneath side and being optically translucent

at least in an area of the detection surface, (ii) a **sealing intermediate element** having an enclosed recess; and (iii) a base element being optically translucent at least in an area of the detection surface of the lid element. The lid element, the intermediate element and the base element together form an optically translucent sample chamber having a chamber space. The first device includes a body and a cover fixable to the body. **The body contains recesses** for a filling unit, a ventilation unit and the second device, and wherein the recesses are arranged such that the sample chamber of the second device may be loaded and vented through **puncturing of the intermediate element from its side**.

The Examiner argues that Blackburn teaches all the elements of claims 44 and 45. Applicants respectfully disagree. As an initial matter, the Examiner has not explained how Blackburn describes a **first device** that contains recesses for a filling unit, a ventilation unit **and a second device** which includes two holding elements that are fixable with each other and that form a layer composite.

Blackburn teaches various configurations of detection chambers (e.g. FIGS. 1A-1J). FIGS. 2A-2C illustrate a detection chamber 102, rubber gasket 104 and "cartridge 114, [which] may optionally contain a cutout 113A for the detection chamber 103 and a recessed microchannel 110 running from the inlet port 100 to the detection chamber 103." (p. 2, paragraph 0011). Blackburn teaches that materials are added to the sample chamber via the inlet port, but does not teach that the chamber can be loaded and vented through **puncturing of an intermediate element from its side**.

Nor does Blackburn teach that a first device for filling a second device can have recesses for a filling unit and a ventilation unit. The nearest Blackburn comes in this regard is FIGS. 15A and 15C, which depict sample chamber with a pipet tip. However, FIGS. 15A and 15C do not depict or otherwise teach a second device having recesses for a filling unit and a ventilation unit, where the recesses are arranged such that the sample chamber of the second device may be loaded and vented through **puncturing of the intermediate element from its side**.

Because Blackburn does not teach all the elements of independent claim 44, or the claims that depend from it, Applicants respectfully ask that the Examiner reconsider and withdraw the rejection.

**Rejections under 35 U.S.C. § 103(a)**

**Lipshutz**

Claims 1, 3, 9, 10, 14-17, and 44-45 have been rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 5,856,174 to Lipshutz et al. ("Lipshutz"). Office Action at 11-14. Applicants respectfully disagree. Claims 1 and 44 are independent.

Claim 1 relates to a device for holding a substance library carrier. **The device includes two holding elements that are fixable with each other, and that form a layer composite** that includes: (i) **a lid element** having a detection surface with a substance library on its underneath side and being optically translucent at least in an area of the detection surface, (ii) **a sealing intermediate element having an enclosed recess**; and (iii) **a base element** being optically translucent at least in an area of the detection surface of the lid element. The lid element, the intermediate element and the base element together form an optically translucent chamber having a chamber space. See claim 1.

Claim 44 relates to a first device for filling a second device for holding a substance library carrier. The second device includes two holding elements that are fixable with each other, and that form a layer composite. The layer composite includes (i) a lid element having a detection surface with a substance library on its underneath side and being optically translucent at least in an area of the detection surface, (ii) **a sealing intermediate element** having an enclosed recess; and (iii) a base element being optically translucent at least in an area of the detection surface of the lid element. See claim 44.

Lipshutz fails to teach all the elements of claims 1 and 44; and nothing in Lipshutz provides a teaching, suggestion, or motivation to provide the missing elements. Nor does common sense or skill in the art supply what Lipshutz lacks.

The Examiner argues that Lipshutz "teaches in **column 19, lines 20-29** . . . use of an oligonucleotide array (substance library carrier as the bottom surface of a chamber," and "[i]n **column 27, lines 1-3** . . . that the base unit [may] include a second surface which contacts the opposite surface of the device." (emphasis added) (Office Action at 11-12). It is not clear that Lipshutz is describing a single device in these passages selected from disparate portions of the

disclosure. Nevertheless, neither the passages mentioned above, nor any other part of Lipshutz, describes a device including two holding elements that are fixable with each other, and that form a layer composite that includes **a sealing intermediate element having an enclosed recess.**

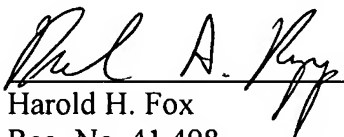

Because Lipshutz does not teach all the elements of claims 1 or 44, there is no *prima facie* case of obviousness. Applicants therefore respectfully ask that the rejection under § 103 be reconsidered and withdrawn.

### CONCLUSION

Applicants ask that all claims be allowed. A petition for a three-month extension of time and the required fee are filed with this reply. Please apply any other charges or credits to deposit account 19-4293.

Respectfully submitted,

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